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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/715,109 | 11/20/2000 | Toshio Sakurai | 862.1731 D2 | 8881 |

5514 7590 07/02/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

NGUYEN, VAN H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2126

3

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PR24

Office Action Summary

Application No.
09/715,109

Applicant(s)
SAKURAI

Examiner
VAN H. NGUYEN

Art Unit
2126



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 20, 2000
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other:

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DETAILED ACTION

1. This Office Action is in response to Application filed November 20, 2000. Claims 30-49 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement filed 11/20/200 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

3. The disclosure is objected to because of the following informalities:
“an warning message” (page 24, line 22) should be “a warning message”
Applicant is requested to review the entire specification and make appropriate corrections.

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Claim Objections

4. Claims 30, 35, 40, and 45 are objected to because of the following informalities:

- claim 30, lines 1-2

“An information processing apparatus to be connected to” should be “An information processing apparatus connected to”

- claim 30, line 8

“connected cable:” should be “connected cable,”

- claim 35, lines 1-2

“an information processing apparatus to be connected to” should be “an information processing apparatus connected to”

- claim 40, lines 2-3

“an information processing apparatus to be connected to” should be “an information processing apparatus connected to”

- claim 45, lines 2-3

“a programmable processing apparatus to be connected to” should be “a programmable processing apparatus connected to”

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 30-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 30, the limitation “a cable” (line 4) is vague and indefinite.
- Claim 35, the limitation “a cable” (lines 4-5) is vague and indefinite.
- Claim 40, the limitation “a cable” (line 4) is vague and indefinite.
- Claim 45, the limitation “a cable” (lines 4-5) is vague and indefinite.

Dependent claims 31-34, 36-39, 41-44, and 46-49 are rejected for fully incorporating the deficiencies of their base claims.

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Double Patenting

6. Obviousness-type double patenting rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. CIT. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Uogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

"Double patenting rejection of application claims was fully justified where applicant, in course of expanding first application to disclose enough more by way of details, alternatives, and additional uses to support broad, dominating, generic claims in later applications, has disclosed no additional invention or discovery other than that what was already claimed in patent on first application; there is significant difference between justifying broadening of claims and disclosing additional inventions." *In re Van Ornum*, 214 USPQ (CCPA 1982).

Claims 30-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of application 09/301,581 filed April 29, 1999, now U.S. Patent 6,210,051 B1.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because of corresponding language that recites many of the same elements and functions claimed in the previously patented invention, e.g., “*an information processing apparatus connected to a device via a cable,*” “*a detecting unit,*” “*an obtaining unit,*” “*a discriminating unit,*” “*a warning unit,*” etc.

The claimed differences would be obvious to a programmer of ordinary skill because the instant claims are merely broader variations of the claims recited in the previously patented invention, e.g., **independent claim 1 of the instant application more broadly claims *an information processing apparatus connected to a device via a cable, comprising:***

a detecting unit adapted to detect whether or not the cable is connected to the information processing apparatus;

an obtaining unit adapted to obtain a device ID in response to a detection, by said detecting unit, of the connected cable;

a discriminating unit adapted to discriminate whether or not a device driver corresponding to the obtained device ID is installed; and

a warning unit adapted to warn when said discriminating unit discriminates that the device driver corresponding to the obtained device ID is not installed in the information processing apparatus as opposed to an information processing apparatus connected to a device via a cable, comprising:

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a detecting unit adapted to detect whether or not the cable is connected to the information processing apparatus;

an obtaining unit disposed such that when said detecting unit detects that the cable is connected to the information processing apparatus, said obtaining unit obtains a device ID of a device connected to a second end of the cable;

a first discriminating unit disposed such that when the obtaining unit obtained the device ID via the cable, said first discriminating unit discriminates whether or not a device driver being activated in the information processing apparatus at the present time is able to control the device on the basis of the obtained device ID; and

a warning unit disposed such that when said first discriminating unit discriminates that the device driver is not able to control the device, said warning unit warns that the device driver is not able to control the device as claimed in independent claim 1 of the previously patented invention. Because the instant claims merely eliminate limitations from the set of elements and functions claimed in the previously patented invention, such modifications would be readily apparent to a programmer of ordinary skill.

Terminal Disclaimer

7. A timely filed terminal disclaimer in compliance with 37 C.F.R. ' 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. ' 1.78(d).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H NGUYEN whose telephone number is (703) 306-5971. The examiner can normally be reached on Monday-Thursday from 8:30AM - 6:00PM. The examiner can also be reached on alternative Friday.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.


Any response to this action should be mailed to:

Commissioner of Patents and Trademark
Washington, DC 20231

or fax to:

(703) 746-7239 (for formal communications intended for entry)
(703) 746-7238 (for After Final communications)
(703) 746-7140 (for informal or draft communications)

Van Nguyen
June 27, 2003


ST. JOHN COURTENAY III
PRIMARY EXAMINER